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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/827,279

04/20/2004

Christopher B. Best

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12/01/2006

BINGHAM MCCUTCHEN LLP  
3000 K STREET, NW  
BOX IP  
WASHINGTON, DC 20007

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/827,279

Applicant(s)

BEST, CHRISTOPHER B.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10-13, 19-22 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 19-22 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is responsive to communication received 11/07/2006 –  
Amendment.

The finality of the last Office action, mailed 09/07/2006 has been withdrawn.

Upon further review, the indicated allowability of claims 1-8, 10-13, 19 and 20 has been withdrawn in view of the further response to applicant's arguments presented below. Any inconvenience to the applicant is sincerely regretted.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 8, 13, 19 and 20 STAND rejected under 35 U.S.C. 102(e) as being anticipated by Solheim ('518).

As to claim 1, note face member (32), body member (12) and dampening member (50). The dampening member (50) is in essence a piece of double-sided tape that is disclosed as being approximately 0.015 inch thick, which anticipates the claimed "approximately 0.02 inch" thickness.

As to claim 3, note hosel (14).

As to claim 4, see the embodiment in Figure 8. Note, the claim does not preclude the attachment of the dampening member to the face member in an indirect fashion.

As to claim 8, Solheim uses a double-sided tape which in essence is an adhesive, as detail, *supra*.

As to claim 13, Solheim clearly shows a putter.

As to claim 19, the dampening member, in this case a double-sided tape, is clearly shown as being of uniform thickness (Figure 7).

As to claim 20, the face (32) is partially in contact with the body (12) adjacent the top and bottom portions of the face member (Figure 9).

Claims 1, 4-7, 10-13, 19, 21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hettinger ('931).

As to claims 1 and 10-12, Hettinger provides a main body (12) serving as the claimed face member, which includes a striking face (32) and a rear surface (18), with the face member having a first perimeter profile. A dampening member or isolation layer (14) is coupled to the rear surface (Figure 9) and has a perimeter profile that is substantially the same as the face member perimeter profile. It is again emphasized here that the entire main body may be considered a "face member", as broadly as claimed. Note the weight body (16) serving as the claimed body member and coupled to the dampening member (14). The dampening member (14) includes a thickness that meets the applicant's claimed limitations, as evidenced by the language in column 4, lines 34-38. Here, the dampening member may comprise a polymer (column 4, lines

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32). The face member (12) is substantially if not completely isolated from the body member (16).

As to claim 4, the dampening member (14) is coupled to the entire rear surface (18) of the face member (12), as shown in Figures 5, 7, 8 and 9.

As to claim 5, note screws (40, 41), which serve as fasteners to further couple the face member (12), dampening member (14) and body member (16).

As to claims 6 and 7, here again it is noted that the face member (12) is completely isolated from the body member (16) by the dampening member (14). Note, that claim 7 in this case does not provide any further limitation or details for the claimed invention that already part of claim 6.

As to claim 13, Hettinger clearly shows a putter-style club head.

As to claim 19, the dampening member (14) would clearly appear to have uniform thickness.

As to claim 21, the dampening member (14) may be formed in color to distinguish it from the body and face members. See column 4, lines 40-50.

As to claim 25, the dampening member (14) is configured to be visible in the normal address position. See column 4, lines 45-50.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrer ('807). Although the specific thickness of the dampening member in Rohrer is not detailed, one of ordinary skill in the art would have found it obvious to dimension the dampening member based in part on the actual size of the putter head. Moreover, the patent to Rohrer indicates that the dampening members are shaped, arranged and sized to provide desired energy absorption. See col. 4, lines 4-22. As to the specific materials required by claim 1, these materials would appear to fall within the broad category of viscoelastic materials that Rohrer mentions, even though no specific material for the vibration absorbent materials in Rohrer is depicted. One of ordinary skill in the art would have found it obvious to select a suitable material based upon the amount of energy absorption required. Moreover, the applicant has not invented the claimed materials. It has long been established that the selection of a known material to take advantage of the known properties of said material would have been obvious to one of ordinary skill in the art. See *In re Hopkins* 145 USPQ 140. As to claim 22, reference is made to Figures 1 and 4, note body member (1), face member (38) and dampening members (17, 19). As the dampening member at the center is diverse from the dampening member located at the heel and toe, it is deemed that the dampening member is comprised of "different materials in toe, center and heel portions thereof", as broadly as claimed. As to claim 25, Rohrer broadly indicates that the elastomeric portions of the head may be partially or fully encased by the club head material for appearance purposes (col. 5, lines 43-50). As such, the skilled artisan would have found it obvious to modify the Rohrer device by providing that the dampening members

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be visible to a user at address, the motivation being to enhance the outward look of the head.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hettinger ('931). Although Hettinger does not disclose aluminum or aluminum alloy for the face member (12) and steel for the body member (16), Hettinger does note that the face member (12) should be of a first material having a density that is lower than the density of the body member (16). Here, "face member" and "body member" are being referenced in the same way that these terms were originally defined under the rejection of claim 1 based upon Hettinger, *supra*. One of ordinary skill in the art would have found it obvious to select suitable materials for the face member and body member based upon the availability of materials and the weight requirements of the putter head. Moreover, the applicant has not invented the claimed materials. It has long been established that the selection of a known material to take advantage of the known properties of said material would have been obvious to one of ordinary skill in the art. See *In re Hopkins* 145 USPQ 140.

### ***Response to Arguments***

At the outset, it is noted that the amendment after final rejection, received 11/07/2006, has been entered. The remarks made by the applicant and submitted with the 11/07/2006 amendment have been considered.

After further and careful reconsideration of the application history, it is apparent that an oversight occurred when considering the previous remarks made of record in an earlier-filed response, received 06/23/2006. At that time, the applicant argued that the

claims, as amended by the 06/23/2006 amendment, were deemed to overcome the prior art references to Solheim (U.S. Patent No. 6,951, 518), Rudell (U.S. Patent No. 4,390,184) and Morrison (U.S. Patent No. 2,820,638). In addition, applicant added new claims 21-25 along with his 06/23/2006 response.

By this current final Office action, the remarks of the 06/23/2006 are again being addressed. Moreover, the reliance upon the newly cited art to Hettinger (U.S. Patent No. 6,095,931), used to formulate the newly made rejections for claims 1, 2, 4-7, 10-13, 19, 21 and 25 and the continued reliance upon the prior art reference to Rohrer (U.S. Patent 6,302,807) to reject claims 1, 22 and 25 in this final rejection are deemed appropriate and proper under the guidelines of MPEP §706.07.

In again reviewing the remarks made by the applicant in the 06/23/2006 amendment and specific to the remarks presented against the Solheim prior art reference, the applicant contends that Solheim does not show a face member substantially isolated from the body member by the dampening member. The applicant presents further remarks against the further rejections previously presented using the Rudell and Morrison prior art references, specifically noting that the Rudell patent does not disclose any of the materials recited in claim 1 for use as a dampening material.

In further response to the 06/23/2006 arguments and in further consideration of the most recently submitted remarks of 11/07/2006, it is noted that a review of the Solheim reference indeed shows that the face member is "substantially" isolated from the main body. Although the applicant may argue that the face insert in Solheim is in direct contact with the body so that "[t]he continuous lip 46 has an outer surface 48 that



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engages side wall 28 of first cavity 24", it is noted that the applicant's claim language, when considered in its entirety and when considered in light of the specification, clearly is intending to make some distinction among the "substantially isolated" face member recited in claim 1, the "completely isolated" face member now required by both claims 6 and 7 and the face member that is in "partial contact" with the body member, as noted in claim 20. Looking at Solheim, one may clearly argue that the rear surface of the striking face, i.e., the rear surface of the face insert (32), is almost entirely isolated from the main body in view of the isolation or dampening layer (44), as shown by Solheim in Figure 9. If one considers that the extent of the rear surface of the face insert (32) from heel to toe and from top to bottom encompasses a substantial amount of the surface area of the face member, then one would have to conclude that the face member is indeed substantially isolated from the body member, as required by claim 1. To the extent that at least a peripheral portion of the face insert in Solheim touches or is in direct contact with the body member, it is clear that this arrangement communicates an interpretation of a "partial contact" between the face member and the body member, as further required by claim 20.

With respect to the arguments previously presented on 06/23/2006 against the rejections using the prior art references to Rudell and Morrison and the further comments presented in the 11/07/2006 amendment against the prior art reference to Rohrer, these arguments are deemed moot in view of the new grounds of rejections applied above and referencing Hettinger and Rohrer.

As has been noted above and as it will be again emphasized here for clarity, the amendment of 06/23/2006 directed that a change be made to claim 6 requiring that the face member be completely isolated from the body member by the dampening member. This exact limitation forms the basis of original claim 7, which is dependent upon amended claim 6. Therefore, it is not understood how claim 7 adds or provides any further structure or clarification to the claimed invention already made a part of claim 6.

#### ***Further References of Interest***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figure 8 and the accompanying description in column 5, lines 29-45 in Gallagher. Note shock-absorbing layer (1) in Liu, which substantially separates the face member from the body member. See Figures 2 and 5 in Pond showing base layer (30). Observe shock-absorbing member (2) in Shieh. In Figures 2 and 4, Chen ('007) provides a complete isolation of the face member from the main body. Kitaichi shows an elastic intermediate member (7), of interest. See Figures 6 and 7 in Chen ('070). See Figures 8 and 9 in Chen ('062). Note the thickness of the gel or silicone layer in Takeda. See Figure 3 in Gilbert.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Passaniti/sp  
November 25, 2006

  
**Sebastiano Passaniti**  
**Primary Examiner**